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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHAIM Y. COHEN, ELDAD PALACHI, and TAKASHI  
SAKAIRI

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Appeal 2016-005466  
Application 13/531,995  
Technology Center 2100

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Before THU A. DANG, KIMBERLY McGRAW, and JOHN D. HAMANN,  
*Administrative Patent Judges.*

DANG, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”) on May 30, 2017 for reconsideration of our affirmance of the Examiner’s rejections of claims 5–12 in a Decision mailed March 28, 2017 (hereinafter “Decision”). The Decision affirmed: The Examiner’s rejection of claims 5–12 under the judicially created doctrine of nonstatutory obviousness-type double patenting (OTDP) over claims 1–4 of U.S. Patent Application No. 13/919,323; the rejection of claims 9–12 under 35 U.S.C. § 101; and the rejection of claims 5–12 under 35 U.S.C. § 103(a)

as unpatentable over the teachings of James et al. (US 5,701,439; issued Dec. 23, 1997), and Clune (US 2006/0064292 A1; published Mar. 23, 2006).

We have reconsidered our Decision regarding the claims in light of Appellants' comments in the Request (Req. Reh'g 2–13). We grant the Rehearing Request to the extent that we consider the Appellants' arguments *infra*, but DENY the request to modify our Decision. We incorporate our earlier Decision herein by reference. *See* 37 C.F.R. § 41.52(a)(1).

## II. ISSUES

The issues we address in this Request is whether Appellants have persuasively identified that the Board misapplied the relevant law or misapprehended Appellants' arguments set forth in the Appeal Brief in finding no error with the following:

1. The Examiner's *provisional* OTDP rejection of claims 5–12.
2. The Examiner's finding that claim 9's "computer-readable storage medium" is not within one of the four statutory categories of a "process, machine, manufacture, or composition of matter" under 35 U.S.C. § 101 (emphasis added); and
3. The Examiner's rejection of claims 5–12 over the combination of James and Clune, by finding the *combination* teaches or suggests a model exporter configured to "*export from the first modeling environment to a second modeling environment*, a description . . . of the association between the discrete system element and the continuous system element" (claim 5, emphasis added).

### III. ANALYSIS

#### *Obviousness-Type Double Patenting (OTDP)*

In the Appeal Brief, Appellants merely contended that “[t]his rejection is not the subject of the present appeal.” App. Br. 4, n.1. Accordingly, in our Decision, we *pro forma* sustained the Examiner’s provisional OTDP rejection of claims 5–12. Decision 5. As set forth in our Decision and consistent with the guidance set forth in our reviewing court, our affirmance of these obviousness-type double patenting rejections is *only provisional*, and “‘might be obviated by future events.’” *Id.*, citing *In re Wetterau*, 356 F.2d 556, 558 (CCPA 1966).

Contrary to Appellants’ contention in the Request that the issue does not become ripe “only until the ‘156 Application has issued” (Req. Reh’g 2), provisional rejections, like all other rejections, are ripe for appeal when an applicant’s claims have been twice rejected. *Wetterau*, 356 F.2d at 558. In addition, although we stated in our Decision, the provisional rejections “‘might be obviated by future events,’” Appellants have not presented any arguments or evidence setting forth how the Examiner’s rejections can be obviated (*id.*; Decision 5).

Although Appellants reference *Moncla* (*Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential)) in the Request, as Appellants acknowledge, *Moncla* addresses a circumstance in which “[t]he only remaining rejection is a provisional non-statutory double patenting rejection” (Req. Reh’g 2, emphasis added). Here, the OTDP rejection is not the only remaining rejection. Further, as set forth in *Moncla*, the Board has the *flexibility to reach or not reach* provisional obviousness type double patenting rejections. *See Moncla*, 98 USPQ2d at 1884; *see also Ex parte*

*Jerg*, Appeal 2011-000044, 2012 WL 1375142, at \*3 (BPAI Apr. 13, 2012) (informative). Here, consistent with *Moncla*, we have the flexibility to opt to reach the provisional rejection.

*35 U.S.C. § 101*

Appellants concede in the Request, “the Board addressed an important argument presented by Appellants” by finding that the paragraph of the Specification referenced by Appellants ““does not support Appellants’ interpretation”” of ““computer readable storage medium”” (Req. Reh’g 2), but Appellants contend “[t]his assertion is newly-presented in the proceedings” which “should be designated a new grounds of rejection” (Req. Reh’g 3).

However, it is not a new ground of rejection for the Board to respond to Appellants’ arguments using different language, so long as the “basic thrust of the rejection” is the same. *See In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). Here, as we noted in our Decision, the Examiner finds the broadest reasonable interpretation of ““computer readable storage medium”” includes ““non-statutory mediums”” under 35 U.S.C. § 101. (Decision 5, citing Final Act. 3). In our Decision, we agreed with the Examiner, stating that we are unpersuaded by Appellants’ contentions, and maintained the basic thrust of the rejection by agreeing with the interpretation of ““computer readable storage medium’ as encompassing transitory signals” (*id.* 6–7).

Furthermore, claim construction is a matter of law that we review *de novo*. *See In re Donaldson Co., Inc.*, 16 F.3d 1189, 1192 (Fed. Cir. 1994). Thus, assuming *arguendo* that our claim construction differs from that of the Examiner, our claim construction supports the Examiner’s conclusion that

claim 9's "computer-readable storage medium" is not within one of the four statutory categories under 35 U.S.C. § 101.

Thus, because the basic thrust of the rejection is the same, i.e., that the broadest reasonable interpretation of "computer-readable storage medium" includes "non-statutory mediums" under 35 U.S.C. § 101 (Final Act. 3), our claim construction supports the Examiner's interpretation, and our Decision merely elaborated on the Examiner's position. Thus, Appellants have been afforded a fair opportunity to respond to the rejection set forth by the Examiner. *See Kronig*, 539 F.2d at 1303.

In the Request, Appellants also state that "Appellants disagree with the Board's assertion that '[the referenced portion in the Specification] does not explicitly define what a 'computer readable storage medium' is, but rather defines what a 'computer readable signal medium' is not.'" Req. Reh'g 3. However, Appellants' disagreement with our Decision is not persuasive of any points we *misapprehended or overlooked* in the Decision.

Nevertheless, we maintain that the broadest reasonable interpretation of "computer readable storage medium" *in light of Appellants' Specification does not exclude* a propagated signal of electromagnetic or optical form, respectively. Decision 6. As we pointed out in our Decision, the Specification indicates the "[p]rogram code embodied on a computer readable medium may be transmitted *using any appropriate medium*" wherein a "computer readable storage medium *may be, for example, but not limited to*" various elements. (Decision 6, citing Spec. ¶¶ 13, 15 (emphases added)). Moreover, we also pointed to paragraph 13, which discloses "a computer readable storage medium *may be any tangible medium than can*

contain, or store a program for use by or in connection with an instruction execution system, apparatus, or device” (*id.*).

Although Appellants contend that “Appellants disagree with the Board’s assertion” (Req. Reh’g 3), Appellants are reminded that the Board does not “assert,” “admit,” “allege,” “argue,” “concede,” “maintain” or engage in other like actions because we are not “parties” to any proceeding. Rather, we are quasi-judicial officials making decisions on a record before us. *Western Electric Co. v. Piezo Technology, Inc. v. Quigg*, 860 F.2d 428, 431 (Fed. Cir. 1988); *Lindberg v. Brenner*, 399 F.2d 990, 990 (D.C. Cir. 1968) (Board of Appeals is a “quasi-judicial” body); *Compagnie de St. Gobain v. Brenner*, 386 F.2d 985, 987 (D.C. Cir. 1967); *Hirsch v. United States*, 203 USPQ 779 (D. D.C. 1978).

35 U.S.C. § 103(a)

Claims 5–12 stand rejected under 35 U.S.C. § 103(a) as *obvious* over the *combination* of James and Clune. As set forth in our Decision, the test for obviousness is what the combined teachings would have suggested to one of ordinary skill in the art. Decision 8, citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). That is, based on the record before us, we were unpersuaded the Examiner erred in finding the *combination* of James and Clune teaches or suggests the contested limitation.

In the Request, Appellants contend that “In re Merck does not apply to the facts of the present application for reasons discussed within the Appeal Brief” wherein these arguments “were either overlooked and/or misapprehended by the Board” (Req. Reh’g 10). According to Appellants, “the ‘full scope of the Examiner’s rejection’ relies exclusively upon James alone to teach the limitations at issue” (Req. Reh’g 9). We disagree.

As Appellants point out, the Examiner finds that “Clune recite multiple environments” wherein it would have been obvious “to combine environments” to arrive at the claimed invention (Req. Reh’g 6–8). That is, as we pointed out in the Decision, the rejection “rests on a combination of references” (Decision 8–9). Even Appellants concede, the Examiner rejects the claims over the *combination* of James and Clune. Decision 8.

As we pointed out in our Decision, for example, the Examiner finds, and we agree, that Clune teaches and suggests “multiple environments.” (Decision 9, citing Ans. 3). Further, we agreed that Clune discloses that the modeling environment must take into account “timing and data management differences between various modeling environments.” (*Id.*). Thus, we agreed with the Examiner’s conclusion that it would have been obvious to combine environments to allow for mixed language software simulations, and thus arrive at the claimed invention. (Decision 9, citing Final Act. 5 (citing James 1:61–66)). As we noted in the Decision, Appellants do not dispute these findings or conclusions in the Appeal. *Id.*

In the Request, even Appellants concede that “Clune teaches and suggests multiple environments as found by both the Board and the Examiner” (Req. Reh’g 12). Appellants further concede “the Examiner [relies] upon Clune to teach a limitation that the Examine[r] previously relied upon James to teach” (*id.*). That is, although Appellants contend that the Examiner “relies exclusively upon James alone to teach the limitations at issue” (Req. Reh’g 9), in the Request, *Appellants concede that the Examiner also relies on Clune* to teach the contested limitation (Request 12).<sup>1</sup> In

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<sup>1</sup> Although Appellants also contend that the Examiner’s finding as to Clune set forth in the Answer “should have been properly designated a new

response to such acknowledgement, Appellants merely add “[t]o the extent that Clune is being relied upon to teach the export of information, the Examiner’s analysis of James, Clune, or the combination of both does not address [the contested limitation]” (Request 13).

As set forth in our Decision, based on the record before us, we were unpersuaded the Examiner erred in finding the combination of James and Clune teaches or suggests the contested limitation. Decision 8. By merely setting forth arguments that the combination of references does not disclose or suggest the contested limitations, Appellants’ Request does not persuade us of any points we *misapprehended or overlooked* in the Decision.

On this record, Appellants have not identified that the Board has misapplied the relevant law or misapprehended Appellants’ arguments.

## V. CONCLUSION AND DECISION

We have considered the arguments raised by Appellants in the Request for Rehearing. Although we have considered our prior Decision in

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grounds of rejection” (Req. Reh’g 12), whether an Examiner’s rejection would or would not properly be regarded as a new ground of rejection is a petitionable matter, not an appealable matter before us. Appellants had the opportunity to raise this issue by filing a timely Petition to the Director under 37 C.F.R. § 1.181, but did not do so.

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light of the Request for Rehearing, we decline to modify our prior Decision in any respect.

We therefore maintain our affirmance of the Examiner's rejections of claims 5–12 under provisional OTDP and U.S.C. § 103(a), and of claims 9–12 under U.S.C. § 101.

REHEARING DENIED